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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,427	10/01/2003	John David Lilley	P68217US1	5662
23548	7590	04/11/2005	EXAMINER	
LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960			YEE, DEBORAH	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/674,427

Applicant(s)

JOHN DAVID LILLEY

Examiner

Deborah Yee

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2-23-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 to 3 ,6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese patent 6-93381 or Japanese patent 4-6247 , which were cited in applicant's IDS dated February 23, 2003.

3. Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Floreen et al (US Patent 3294527).

4. Each reference teaches specific iron alloy compositions which meet the claims. See JP'381, alloy 27 on page 521 and alloys 11,16, and 20 on page 519; JP'247, alloy 30 on page 276; and Floreen, alloys 2 and 4 in Table 1 of column 4.

5. Even though a graphite –free microstructure as recited by the claims is not taught by prior art, such would be expected since the compositional limitations are met, and in absence of proof to the contrary.

6. Even though prior art does not teach using alloy for gas turbine or internal combustion engine exhaust system parts as recited by the claims, such would not be a patentable distinction because it is merely applicant's future and intended use .

7. In regard to claim 9, prior art does not aging step.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 6-93381 or Japanese patent 4-6247 , which were cited in applicant's IDS dated February 23, 2003.

10. Claims 1 to 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floreen (US Patent 3,294,527) or Floreen (U S Patent 3,318,690) which were cited in applicant's IDS dated February 23, 2003.

11. The English abstract of JP' 381 , the English abstract of JP'247, claim 3 in column 6 of Floreen'690, and claim 2 of column 6 of Floreen'247, each teach an iron alloy having a composition with constituents whose wt % ranges overlap those recited by the claims; such overlap renders applicant's composition prima facie obvious because it would be obvious to one of ordinary skill in the art to select the claimed alloy wt% ranges from the broader disclosure of the prior art because the prior art has similar high and low temperature resistant properties, see MPEP 2144.05,

12. Even though a graphite –free microstructure as recited by the claims is not taught by prior art, such would be expected since the compositional limitations are closely met, and in absence of proof to the contrary.

13. Even though prior art does not teach using alloy for gas turbine or internal combustion engine exhaust system parts as recited by the claims, such would not be a patentable distinction because it is merely applicant's future and intended use.

Furthermore the Floreen patents teach using alloy in high strength structural application which would broadly include gas turbine and engine components.


14. The Floreen patents teach age hardening iron alloy. Even though precipitation of  $\text{Ni}_3(\text{Nb}, \text{Al}, \text{and/or Nb})$  or  $\text{Mo}_2\text{C}$  as recited by claims 7 and 8 are not taught, such would be expected since compositional limitations are closely met and in absence of proof to the contrary.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1742

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Deborah Yee  
Primary Examiner  
Art Unit 1742

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